



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/612,419

07/02/2003

Joel R. Jaffe

47079-00212

3591

30223 7590 01/22/2007
JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER

HARPER, TRAMAR YONG

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/612,419	Applicant(s) JAFJE ET AL.	
	Examiner Tramar Harper	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment received on 10/27/06. The arguments set forth in the response are addressed herein below. Claims 1-14 & 16-25 remain pending, Claim 15 has been canceled, and Claims 1-2, 9, 18, & 24-25 have been currently amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-11, 16, 18-20, & 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al (US 2003/0064806).

Claims 1-2, 9-10, & 18-19: Gordon discloses a wagering game that comprises of an electro-mechanical award display. The award display includes a plurality of mechanically actuated "Cuckoo" birds movable upon a retractable and extendable position through an associated door (Fig. 5). The location and position of each "Cuckoo" bird indicates an associated game outcome. The "Cuckoo" birds move relative to the housing (Fig. 5, ¶ 38-39). Gordon discloses that the game may be a secondary game associated with a primary game such as a slot machine. Gordon further

Art Unit: 3714

discloses that a secondary or bonus game is triggered once a player reaches a predetermined trigger point/condition within the base game (§ 13, 38-39).

Claims 3, 11, & 20: The birds protrude from the panel of the gaming device through the associated door in an extended position and are approximately flush with the panel when in the retracted position (door closed) (Fig. 5).

Claims 7 & 24: Gordon discloses a central processor within the gaming machine that is configured to actuate the birds in an extended or retracted position indicating an outcome based on the associated position of the said birds (Fig. 5, § 40).

Claims 8, 16, & 25: Each of the birds is associated with a respective outcome (Fig. 5).

Claims 1-2, 4, 6-10, 12, 14, 16, 18-19, 21, & 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Nordman et al (US 2004/0053687).

Claims 1-2, 9-10, & 18-19: Nordman discloses a gaming apparatus that comprises of electro-mechanical award display (§ 37). The award display includes a plurality of octopus legs movable upon a retractable and extendable position (Figs. 11 & 13-14). The location and position of each of the octopus legs indicates an associated game outcome (§ 51). The octopus legs move relative to the housing (§ 85-87, Figs. 11 & 13-14). Nordman discloses that the game may be a secondary game associated with a primary game such as a slot machine (§ 37). Nordman further discloses that a secondary or bonus game is triggered once a player reaches a predetermined trigger point/condition within the base game (§ 45).

Art Unit: 3714

Claims 4, 12, & 21: The octopus legs are approximately flush with the panel or housing when in the extended position and are recessed when in the retracted position (§ 87, Figs. 11 & 13-14).

Claims 6, 14, & 23: Nordman discloses that the legs are movable in sequence (Abstract).

Claims 7 & 24: Nordman discloses a processor that operates the legs in between the extended position and retracted position, stops the elements in either position, provides a result based on the relative position of each leg (§ 85-87).

Claims 8, 16, & 25: Each of the legs is associated with a respective outcome (§ 51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 13, & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nordman et al (US 2004/0053687).

Claims 5, 13, & 22: Nordman discloses the limitation with respect to Claims 1, 9, & 18, but excludes the physical elements/indicators arranged in a line. Nordman discloses the physical arrangements in a circle (Figs. 11 & 13-14). Applicant discloses that the physical elements can be arranged "in a regular or irregular non-linear configuration. For example, the physical elements 38 may be arranged in a closed configuration such as an oval, circle, triangle, rectangle, pentagon, hexagon, octagon, or other polygonal

shape." Applicant has not disclosed the having an arrangement in a line solves any stated problem or is for any particular purpose. Applicant discloses that any arrangement stated above is suitable. Moreover, it appears that the circle arrangement of Nordman, or applicant's invention, would perform equally well with the physical elements arranged in any manner.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Nordman such that the physical elements/indicators were arranged in a line because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Nordman.

Response to Arguments

Applicant's arguments with respect to Claims 1-2, 9, 18, & 24-25 are have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Seelig (US 2004/0043811, US 2002/0094861, US 2004/0053658, & US 6,814,665), Rothranz (US 2005/0054424), Nordman (US 2004/0053671), Gornez (US 2005/0049028), McComb (US 2005/0059454), & D'Avanzo (US 2006/0019733) all teach bonus gaming with various types of bonus indicators.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH

01/09/06

 1/11/07
ROBERT OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700